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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,295	11/13/2001	Linda Ann Roberts	BELL-0130/01183	2697

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EXAMINER
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MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/008,295

Applicant(s)

ROBERTS ET AL.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-12 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki et al (6,470,323).

Regarding claim 12, Suzuki shows a server 1 with an interface connected to a network 2 (see Fig. 1); a processing engine having a processor capable of executing instructions for providing the shopper an opportunity to select a notification option, of receiving purchasing information from the shopper containing a request to purchase goods and notification information, of providing the shopper with delivery information, of recognizing the occurrence of a triggering event that affects delivery, of notifying the shopper of the triggering event, and of notifying the shopper of a changed delivery date; and a data storage facility capable of storing all recited information. It is noted that all "for..." elements are interpreted as intended use only.

Alternatively, claim 12 shows all elements of the claim except that the processing engine is capable of providing a shopper with an option to supply notification information. However, it is notoriously old and well known in the art to do so. One of ordinary skill in the art would use a processing engine capable of providing an option to the user to provide contact information in order to protect customer privacy and in order

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to avoid losing sales to customers who are unwilling to provide mandatory contact information.

As to claim 15, it is inherent that Suzuki has a message routing agent adapted to receive notification information since the system routes customer messages and must receive notification information to do so.

Claims 1, 3, 6, 7, 9, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al (2003/0149640) in view of Murcko, Jr. (6,578,014).

As to claims 1, 7 and 12, Fisher et al show receiving via an electronic network purchasing information comprising a purchase request and notification information from the shopper 210 electronically via a network 275; creating a shopper profile associated with the shopper containing the purchase request and notification information (e.g., par. 0019, lines 1-3); providing the customer with delivery information; recognizing the occurrence of a triggering event comprising a change in shipping status; notifying the shopper that the triggering event has taken place; and notifying the shopper of a changed delivery date. Fisher et al do not show providing the shopper with an electronic purchase order having an opportunity to select a notification option on the purchase order and providing electronic purchase information, or notifying the shopper of the triggering event only if a notification option has been selected. Murcko, Jr. shows sending the shopper the notification only if a notification option has been selected. It would have been obvious to one of ordinary skill in the art to modify the method of Fisher et al by optionally sending the information as taught by Murcko in

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order to promote customer satisfaction by allowing him to tailor the shopping experience to his liking. As to providing the shopper with an electronic purchase order having an opportunity to select a notification option on the purchase order and providing electronic purchase information, it is notoriously old and well known to do so (for instance, it is well known to provide a purchase order on which the shopper enters payment information, his name, etc. and can select optional notification options such as email, work phone or cell phone for transmitting information to the customer). It would have been obvious to one of ordinary skill in the art to provide the shopper via a communication network with an electronic purchase order having further modify the method of Fisher et al by providing an opportunity to select a notification option on the purchase order in order to provide additional communication paths with the customer.

Regarding claim 7, it is noted that system of Fisher et al in view of Murcko show all elements of the claim as discussed above.

As to claims 3 and 9, it is noted that Fisher et al show an email address.

As to claim 6, Fisher et al in view of Murcko show the Internet.

As to claim 15, it is noted that Fisher et al in view of Murcko show all elements of the claim.

Claims 4, 5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al in view of Murcko, Jr. as relied upon in claims 1 and 7

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and further in view of "Presence: the Best Thing That Ever Happened to Voice" (hereafter Presence).

As to claims 4 and 10, Fisher et al in view of Murcko show all elements of the claim except notification information comprising presence information. Presence shows notification information comprising presence information. It would have been obvious to one of ordinary skill in the art to further modify the method of Fisher et al by using presence information in order to determine how the person would prefer to be contacted, therefor creating greater customer satisfaction.

As to claims 5 and 11, it is noted that Fisher et al in view of Murcko and Presence shows notification information representative of a plurality of pathways with each having a preferred rank (see second paragraph of page 1 of Presence and 768 of Murcko).

### ***Response to Arguments***

Applicant's arguments filed 12/30/2004 have been fully considered but they are not persuasive.

Regarding the Suzuki rejection, the examiner regrets if a miscommunication occurred. While a positive recitation of computer readable instructions embedded on a tangible medium causing the system to perform the steps recited would overcome the Suzuki rejection, the present amended recites only a microprocessor "for" executing the instructions and a data storage facility "for" storing the recited data.

Regarding the shopper profile in the Fisher rejection, the examiner respectfully disagrees. It is noted that the text suggesting that the shopper profile is undesirable

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refers to Brookes in which a shopper profile contains special information regarding the user's interests, stocks owned, etc. As recited in the claim, however, the profile is simply a data structure containing the notification information and purchase request data. Contact information and purchase information associated with the customer is stored as discussed in par. 0019 of Fisher.

It is noted that as broadly claimed "having an opportunity to select a notification option" could refer to having the opportunity to provide an optional phone number or an optional email address, as is often provided on electronic purchase orders, as opposed to providing an option to select whether the user wishes to be contacted.

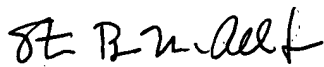
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

**STEVE B. MCALLISTER**  
**PRIMARY EXAMINER**